

## Remarks

### General

Applicant has amended the title of the invention to particularly emphasize its novelty and benefits.

Applicant has rewritten all claims to define more particularly and more distinctly the novelty and uniqueness of the invention in light of the prior art and to clearly define and distinguish the invention as patentable over the prior art.

### The Rejection of Claim 1 under 35 USC §102(b)

The Office Action has rejected Claim 1 as being anticipated by Giard (5,671,481), stating that Giard teaches a wallet shaped to fit in a front trousers pocket having rounded tapering around one edge.

Giard '481 teaches a sweatband for wearing around a wrist or ankle, where in use it assumes a cylindrical form with a V-shaped notch to allow free wrist or ankle joint motion (see Giard Figure 1). Applicant's invention is a wallet for use inside a front trousers pocket, where in use it lies flat in a planar configuration (see Applicant's Figure 1).

Giard shows at Figures 5 and 6 a particular folding which the Office Action construes as anticipating Applicant's invention. This conclusion is incorrect.

It is inappropriate to arbitrarily select a singular view of one device in one uniquely-folded configuration and then to construe this view as analogous with another device in a totally differently-folded configuration. A picture must show all the claimed structural features and how they are put together in order to anticipate a claim. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928).

Figures 5 and 6 depict Giard's sweatband in its closed, ready-to-wear configuration as in Applicant's Figure 1. Giard's figures clearly show rounded tapering along two — not one — edges. Figure 7 of Giard depicts her sweatband in its unfolded, open-for-access configuration, the view properly analogous to Applicant's Figure 2. Giard's Figure 7 shows rounding at four places.

Giard's sweatband, when accessible for its wallet or purse function, is as shown in Figure 7 in its unfolded, unfastened position. Items held inside are inserted and removed through the left end (as depicted) at pocket 100. When fully folded, as in Figures 5 and 6, pocket 100 is closed to prevent their loss.

Applicant's wallet in its open, unfolded position, shown at Figure 2, holds items in a conventional wallet pocket formed along one of its edges, as shown in Figure 2.

Giard teaches a sweatband which when wrapped around one's wrist may serve, among many other functions, the function of a wallet or purse for carrying small items. A wallet as in Applicant's invention is a wallet, and in use is never envisioned as cylindrical, but rather as flat.

As a true wallet, Applicant's invention is not limited to carrying such small items as may easily disperse around a wearer's wrist. Rather, Applicant's wallet routinely is expected to carry such larger, rigid and planar items as credit cards, bank notes and checks, photographs, business cards, calculators, and other digital devices such as Apple Computer's currently-new iPod Nano.

That Giard teaches one in a combination of functions for her sweatband to be its ability to hold small items, as could be held in a wallet or purse, does not demonstrate priority over Applicant's invention. A paper cup may serve the function of a wallet or purse in this manner as well. Clearly it would be improper to construe a paper cup as anticipating a wallet.

During examination, the claims must be interpreted as broadly as their terms reasonably allow, though the words in a claim are not generally limited in their meaning by what is shown or disclosed in the specification. At every claim, Giard declares clearly that her invention is a sweatband. At every claim, Applicant declares his invention to be a wallet. The words of the claim must be given their plain meaning, unless an applicant has provided a clear definition in the specification, and it's important not to import into a claim other limitations that are not part of the claim. For example, a select embodiment appearing in the written description of Giard — for instance one offered functionality, among others, as a wallet or purse — may not be read into a claim when the claim language is broader than the embodiment. Giard's claims are so broader, all directed to a sweatband and nowhere citing or limited by this wallet or purse functionality at all.

*In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.

*In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) During examination, "Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." Applicant, throughout, restricts his wallet to be nothing more than a wallet.

*Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) "In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art." It is the use of the words in the context of the written description and as customarily used by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. Giard discloses a sweatband and at no time suggests or envisions her sweatband being used as a wallet, in any pocket.

*Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003) Dictionary definitions were used to determine the ordinary and customary meaning of words to those skilled in the art. In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor.

*Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999) "[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning." The field of Giard is garments, apparel and wristlets, while the field of the invention deals with wallets to be carried by the person. There is no indication that Giard's function as a wallet or purse could be construed to mean that her sweatband is or could be in fact a wallet or purse, nor that one skilled in the art of apparel would be conversant with the invention of a wallet or a purse.

A sweatband is a sweatband; a wallet is a wallet. Giard does not reveal or teach a wallet.

*Rapoport v. Dement*, 254 F.3d 1053, 1059-60, 59 USPQ2d 1215, 1219-20 (Fed. Cir. 2001) Both intrinsic evidence in Applicant's disclosure and the plain meaning of the term "wallet" support construction of the term "wallet" as being limited to a wallet itself, and not to encompass the entirely different construction of an item of clothing or apparel.

*Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002) Where Applicant has clearly disclaimed scope of coverage by consistently using the words "wallet for use in trousers front pocket," the claim must be understood to be limited to that construction and not to be understood as an item broadly incorporating wallet or purse functionality.

*Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996) One must construe the term "wallet" to mean a wallet, rather than a sweatband incorporating some

function of a wallet or purse, in order to remain consistent with the specification.

See also discussions in MPEP 2111.02 on the effect of preamble language in limiting structure. It is manifestly clear that the preamble, or the leading words of the claim, acts to limit the structure when it gives life, meaning and vitality to the claim and where the entirety of the application give a clear understanding of what the inventor actually invented and intended to encompass by the claim.

Where a preamble merely states the purpose or intended use of an invention, then there is no such structural limitation, but here Applicant clearly claims his invention to be limited in structure to a wallet shaped to fit a trousers front pocket. Giard's sweatband has a totally different structure.

*In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987) In the context of the Applicant's specification, the words "shaped to fit a front trousers pocket" set forth structure which cannot be ignored, in that it limits the structure of the claimed wallet. The framework against which patentability is measured is not all things that comprise the function of a wallet or purse, but only wallets that are shaped to fit a front trousers pocket.

*In Re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) The Office Action must provide rationale or evidence tending to show inherency. The allegation that Giard teaches a substantially tapered rounding along one edge is not supported as inherent without the Office Action's visionary folding of Giard's sweatband in a manner neither intended nor suggested, nor even envisioned by any wristband in the prior art.

The Office Action allegation can also be rebutted by the evidence related above showing that Giard's sweatband does not necessarily possess the characteristics of Applicant's claimed wallet. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Even if Giard's sweatband performs all the functions recited in the claim, Giard cannot anticipate the claim if there is any structural difference whatever. *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965) as implicitly modified by *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

To anticipate a claim, the reference must teach every element of the claim. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim. A claim is anticipated only if each and every element as set forth in the claim is found. Giard '481 fails this test.

Applicant's invention is completely distinct and solves a completely different problem in a completely different manner from Giard's sweatband. Whereas this stands evident in Applicant's specification, which must be considered as background and as a part of the claims, it has now been written into the claim as well, at new Claim 12.

Reviewing new Claim 12, note that Giard does not teach a folding pocket wallet, and that even gratuitously folding Giard in an unforeseen manner does not create a shorter edge defining the edge of a money pocket, nor does Giard in any way obviate spinal or neurological damage.

Applicant submits that Claim 12 defines patentably over the prior art and is now in condition for allowance, which action is respectfully requested.

#### **The Rejection of Claim 2 under 35 USC §102(b)**

The Office Action has rejected Claim 2 as being anticipated by Giard '481, stating that Giard teaches a wallet shaped to fit in a front trousers pocket which when unfolded has rounded tapering around two diagonal legs.

As explained above, Giard Figures 5 and 6 depict her sweatband in its fully folded and ready-to-wear configuration, while Applicant's Claim 2 defines his wallet in its unfolded and open configuration — as clearly stated in that claim. Figure 7 of Giard depicts her sweatband in its unfolded and open-for-access configuration. In Figure 7, analogous to Applicant's Figure 2, Giard plainly shows a shape which cannot be construed as an isosceles trapezoid, and which plainly shows convex rounded edges at four — not two — edges. Figure 10 of Giard shows an alternative embodiment of her sweatband in a partially unfolded position, from which it may fairly be inferred that, fully unfolded, Giard's alternative embodiment would have (to coin a term) a "butterfly" shape.

Claim 2 has been rewritten as new Claim 13, to more clearly distinguish it from the prior art.

Reviewing new Claim 13, note that Giard does not teach a fold line extending from edge to edge, nor a substantially flat folding pocket wallet that's shaped to fit a front trousers pocket or that obviates spinal or neurological damage.

Applicant submits that Claim 13 defines patentably over the prior art and is now in condition for allowance, which action is respectfully requested.

**The Rejection of Claim 3 under 35 USC §102(b)**

The Office Action has rejected Claim 3 as being anticipated by Giard '481, stating that Giard teaches at Figure 13 a wallet shaped to fit in a front trousers pocket which when folded as in Figure 6 has an outer panel, an inner panel and a separator panel as in Claim 3.

As discussed above, Claim 3, dependent upon Claim 2, defines Applicant's wallet in its unfolded position, not in its folded configuration. When Giard Figure 13 is folded as in Giard Figure 6, its outer panel 20 would cover all exposed surfaces so the wearer can enjoy the comfort and absorbency of the outer panel against his wrist. There is no inner panel, and there is no separator panel, at all.

The Office Action further contends that when folded as in Figure 6, Giard's portion 210 in Figure 13 would have two separator panels fastened along seam 40. But in her own specification, Giard defines 40 and 230 as fold lines, never as seams, and defines feature 210 simply as an edge, not a portion.

Also not clearly understood, the Office Action mentions an internal panel in Figure 11. Figure 11 shows no such internal panel; it does show second panel 90 and a stack of removable, disposable layers such as tissues or Handi-Wipes™. Second panel 90 is said to be folded along a longitudinal fold line 120, which is not disclosed in Giard's drawings. It's thus difficult to interpret exactly the disposition of this purported internal panel.

Claim 3 has been rewritten as new Claim 14, to more clearly distinguish it from the prior art.

Reviewing new Claim 14, note that Giard does not teach three separate panels substantially identical in shape, nor a fold line as claimed in Claim 13.

Applicant submits that Claim 14 defines patentably over the prior art and is now in condition for allowance, which action is respectfully requested.

**The Rejection of Claims 4-6 and 8 under 35 USC §103(a)**

The Office Action rejects Claims 4-6 and 8 under 35 USC §103(a) in light of Giard '481 and Sandos (4,209,048), stating that it would have been obvious to provide an internal panel in Giard as taught by Sandos, noting the couple of layers in Sandos' inner and outer panels to provide extra strength.

Sandos discloses a wallet that floats, using unique combinations of specified fabrics in a layered structure that results in this flotation. There is no suggestion whatsoever that Sandos' teachings would, should or even could be applied to Giard's sweatband. For her sweatband, Giard calls for water-absorbent materials (to absorb perspiration) where Sandos teaches liquid-resistant and non-

absorptive materials layered in such a way as to provide flotation if dropped into water. To the contrary, Giard and Sandos teach apart.

The Office Action suggests that combining Giard and Sandos would be obvious to provide added strength, yet neither Giard nor Sandos, and surely not the Applicant, anywhere raise the issue of strength, that would be added by panels or otherwise. Prior art references must suggest such a modification, and its desirability. *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In Re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Further, the Office Action states it would have been obvious to provide added pockets in Giard to provide added storage. Yet Giard's sweatband must be soft enough and flexible enough to wrap comfortably around a user's wrist. Giard takes pains to not add layers or pockets, as their additional stiffness, especially when stitched to adjacent panels, would be disadvantageous. Adding layers that are not attached cumulatively adds to the sweatband's overall stiffness; fastening them, as would be required to form a pocket, creates a structure much more rigid, proportional even to the third power, or cube, of the added material. If combined, Sandos' pockets would be detrimental to Giard's sweatband.

There is neither logic nor suggestion to combine Giard and Sandos. Even if so combined, the references would not meet the claims, dependent as they are from Claims 3 and 4, now re-written as Claims 14 and 15.

Reviewing new Claims 15, 17 and 19, note that Giard combined with Sandos does not teach three separate panels as in Claim 14 nor a fold line as in Claim 13 extending from a shorter edge to a longest edge.

Applicant submits that Claims 15, 17 and 19 define patentably over the prior art and are now in condition for allowance, which action is respectfully requested.

#### **The Rejection of Claims 7, 9 and 11 under 35 USC §103(a)**

The Office Action has rejected Claims 7 and 11 as being unpatentable over Giard '481 in light of Sandos '048 and Jacks (5,341,972), stating that it would have been obvious to provide a pocket with a slot for a key as taught by Jacks. It also rejects Claim 9 over Giard in view of Williams (4,570,688) in that Williams provides a transparent pocket.

Concerning the key pocket, it's clear from Giard, especially at Figure 2, that she has considered keys to be among the small items which may be carried in her sweatband. Since a rigid key cannot fit

across fold line 40, Giard suggests it be inserted endwise along the sweatband so the key will be narrower. Jacks, to the contrary, imagines his keys oriented a full 90 degrees from Giard. Though patent drawings are not to scale, it's evident that Giard's sweatband is narrower than Jacks'. Moreover, a key slot as in Jacks '972 would be prohibitively difficult and costly to incorporate into Applicant's wallet, requiring as it would substantial extra stitching in an inaccessible place. Whereas Applicant has invented a pocket wallet, the exact orientation of keys is of no particular consideration. Only where Applicant's novel construction creates a corner space as shown in Figure 3 does the orientation matter at all, and there a slot would be entirely inappropriate.

Depending as they do now upon Claims 15, and thus 14 and 13 as well, all of which have been rewritten to place them in patentable form for allowance, these rejections are overcome.

Applicant submits that new Claims 18, 20 and 22 define patentably over the prior art and are now in condition for allowance, which action is respectfully requested.

#### **The Objection to Claim 10 as being Dependent on a Rejected Claim**

Applicant respectfully requests reconsideration and withdrawal of this objection; as all claims upon which Claim 10 depends are now in allowable form, this objection is met.

#### **Prior art made of record but not relied upon**

Applicant has reviewed the four cited U.S. patents in detail and finds they do not anticipate the subject matter of this application.

#### **The Declaration under 37 CFR §1.132**

The health costs associated with spinal misalignment and back pain are entirely disproportionate to those of drying athletic sweat or losing a wallet. Applicant has pursued the development and marketing of his wallet diligently and spent considerable personal time and money in doing so. He has obtained endorsements for its efficacy and received outside interest in his invention rights. Product has already been sold, albeit in limited pre-production quantities, and setup for production is underway. The wallet is available on the global market through the eBay Website. A quick search for the terms "front pocket wallet" on the Internet finds many citations, which is broadly indicative of the market potential, yet not one of these shows or suggests Applicant's unique structure.

Applicant submits herewith a Declaration of supporting facts.

Exhibit I is a sample of Applicant's wallet.



Exhibit II is a point-of-sales placard to be used with Attachment I.

Exhibit III is a typical trousers front pocket.

Exhibit IV is an image of the Website <[www.all-ett.com](http://www.all-ett.com)> showing a typical competitive product in Applicant's market, noting the location of the wallet in a rear trousers pocket and the problems associated therewith. Visiting this Website offers many valuable perspectives on why Applicant's invention is desired.

Exhibit V is an image of the eBay Website through which the invention is being marketed.

### **Conclusion**

For the reasons given above, Applicant submits that Claims 1-11, re-written as new Claims 12-22, are now in definite and proper form, that they all define patentably over the prior art, and that this application is now fully in condition for allowance.

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